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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,174	02/08/2000	Yasuharu Katsuno	JA9-99-044	2214

7590

04/22/2004

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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT PAPER NUMBER

2681

DATE MAILED: 04/22/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/500,174

Applicant(s)

KATSUNO ET AL.

Examiner

Eliseo Ramos-Feliciano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The amendment filed on January 30, 2004 introduces 112-2nd issues as follows.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 5, 6, and 9** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 5 recites the limitation "that mobile station" in line 4. It is unclear what mobile station is being referred to since the claim, including its base claims, recites mobile stations in plural form.
4. Claim 6 recites the limitation "that mobile station" in line 13. It is unclear what mobile station is being referred to since the claim recites mobile stations in plural form as well as "another mobile station" in line 7.
5. Claim 9 recites the limitation "that mobile station" in line 9. It is unclear what mobile station is being referred to since the claim recites mobile stations in plural form.
6. Claim 1 recites the limitation "said mobile stations to be called" in line 10. There is insufficient antecedent basis for this limitation in the claim. This is the first mention of a mobile station "to be called".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. **Claims 1-13** are rejected under 35 U.S.C. 102(e) as being anticipated by Kimoto et al. (US Patent Number 6,115,611):

Regarding **claims 1, 7 and, 11**, Kimoto et al. discloses a mobile communication system (see abstract) for calling one or more mobile stations (4; Figure 8) located within a designated communication area including location receipt and storage means (information center 5; database 52; *inter alia*; either singularly or in combination; as shown in Figure 8) for receipt and storage of the locations of the mobile stations transmitted to the location receipt and storage means by the mobile stations over a communication network (6, 7; either singularly or in combination) and the Internet (8). The system further includes designation accepting means (52a-53b; either singularly or in combination) for accepting the designation of the communication area based on the stored locations (e.g. CSID; see column 17, lines 28-39, column 31, lines 30-47, column 36, lines 17-26); mobile station selection means (5, 51; either singularly or in combination) for selecting the mobile stations to be called based on the accepted communication area and the stored locations of the mobile stations; and calling means (6, 5; either singularly or in

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combination), for calling the selected mobile stations to be called. Figure 8 illustrates the system. Figure 9 shows that the position information includes latitude and longitude; see also Figure 21, step S33. The location is detected by a GPS location detection means (position detecting unit) in the mobile station; see Figure 21, step S32; and column 3, lines 15-17, column 36, lines 54-60, column 37, lines 47-55, *inter alia*. Figures 19-20, step S25, show that the information center stores the position in the database. Figure 27, illustrates database 52, including position information 525. See columns 3-14 and 33.

Regarding **claims 2-3**, Kimoto et al. discloses everything claimed as applied above (see claim 1). In addition, Kimoto et al. teaches that calls are placed in a designated time zone to one or more mobile stations located within a designated communication area. See column 40, lines 25-40, column 43, lines 24-49, and column 44, lines 34-43.

Regarding **claims 4-5**, Kimoto et al. discloses everything claimed as applied above (see claim 1). In addition, Kimoto et al. teaches a base station (6, Figure 8) and a "calling device" (combination inside INFORMATION CENTER 5, Figure 8). As explained above, each mobile station includes a GPS location detection means (position detecting unit), and a location notification means (position information transmitting unit); see Figure 21, step S32; and column 3, lines 15-17, column 36, lines 54-60, and column 37, lines 47-55.

With respect to **claims 6 and 8**, they are the analogous reciprocal system and method claims of system and method claims 1 and 7, respectively. Therefore, they are rejected for the same reasons above.

With respect to **claims 9 & 12 and 10 & 13**, they are the corresponding recording medium (computer program) claims of system claims 1/5 and 6. Therefore, they are rejected for the same reasons above.

Citation of Pertinent Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Loomis et al. (US Patent Number 5,625,668) discloses a GPS based position reporting cellular telephone;

Pu et al. (US Patent Number 6,292,743) discloses a wireless client navigation system.

Response to Arguments

10. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A. Gary, can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PATENT EXAMINER

ERF/erf

April 16, 2004


ERIKA GARY
PATENT EXAMINER